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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,519	01/24/2001	Regina J. Liu	ST9-99-177(A8062)	6767

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EXAMINER	
SMITH, JEFFREY A	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/771,519	LIU ET AL.	
	Examiner	Art Unit	
	Jeffrey A. Smith	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The response filed December 20, 2005 has been entered and considered.

Claims 1 -67 are pending.

Claims 1, 9, 14, 15, 21, 29, 34, 41, 49, 54, 61, and 64 are currently amended.

An action on the merits of claims 1-67 follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15-33, 35-53, 55-63 and 65-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Couch et al. (U.S. Patent No. 6,631,381 B1).

Couch discloses a method for executing a statement to manipulate data stored in a data store connected to a computer.

The method comprises receiving the statement for a transaction (col. 10, line 63-col. 11, line 10); in response to the receipt of the statement for the transaction, generating a private catalog for the transaction to record information about the objects (col. 10, line 19-col. 11, line 11); and using the private catalog during the transaction to access the objects (col. 9, lines 4-18).

Couch discloses that the private catalog is populated with an identification attribute (col. 10, lines 35-45).

Couch discloses an apparatus comprising a computer having a data store connected thereto and one or more computer programs performed by the computer (Fig. 1).

Couch discloses an article of manufacture comprising a computer program carrier readable by a computer and embodying one or more instructions executable by the computer to perform method steps for executing a statement to manipulate data (col. 4, lines 7-12).

The recitations that the objects are "private", "non-private", "user-defined", or "system" is of no patentable consequence. Such descriptors do not move to further define or

distinguish the method steps or structure of either the article or system from the invention of Couch.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14, 34, 54, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Couch et al. (U.S. Patent No. 6,631,381 B1) in view of Hammond (U.S. Patent No. 5,758,337).

Couch does not disclose that the generating of the private catalog comprises filling in records of the private catalog only with information that relates to tables accessed by the transaction and wherein the private catalog records that relate to tables not accessed by the transaction remain unfilled.

Hammond, however, in the field of database management, and in particular to a system for generating partial replicas of a database (col. 1, lines 5-10), that a database replica might be

a replica of the entire original database or it might only duplicate one or more record sources of the database (col. 1, lines 64-67).

It would have been obvious to one of ordinary skill in the art to have provided the methods, apparatus and article of manufacture of Couch to have provided that the generating of the private catalog comprises filling in records of the private catalog only with information that relates to tables accessed by the transaction and wherein the private catalog records that relate to tables not accessed by the transaction remain unfilled (amounting to a partial replica of the type taught by Hammond). Such modification would have proved advantageous in the situation where each individual user of the database only needs access to a subset of the record sources that make up the full database rather tan needing access to the entire database (col. 1, line 67-col. 4).

Response to Arguments

Applicant's arguments filed December 20, 2006 have been fully considered but they are not persuasive.

Applicant remarks that "Couch fails to disclose automatically generating a copy of the catalog" and that "the

user-generated copies are not created in response to a transactional request for which this catalog copy is used" (original emphasis).

The Examiner disagrees.

Couch discloses at column 10, lines 26-34:

"At a step 138, a copy 87, 89 of the catalog 88 is generated. The generation of the copy 87, 89 may be conducted by the database system 54, but is preferably conducted by a user. Multiple copies 87, 89 may be generated, and different users may copy and modify individual copies 87, 89 to suit their needs. In order to identify the copies 87, 89 names are given to the copies 87, 89. Preferably, these names comprise high-level qualifiers, and are assigned in a step 140."

The names of catalog tables may comprise a high-level qualifier and one or more low-level qualifiers. For example, a DB2 catalog may contain table names, such as SYSIBM.SYSINDEXES, SYSIBM.SYSTABLES, SYSIBM.SYSPLANS, etc. In the above case, SYSIBM is a high-level qualifier, and SYSINDEXES, SYSTABLES, and SYSPLANS are low-level qualifiers. A copy of the catalog tables would preferably have a different high-level qualifier than the catalog, but the low-level qualifier would be the same so that the query explain program 50 still understands which catalog table is being accessed." (emphasis added)

Further, at column 10, line 63-column 11, line 11:

"At a step 148, a function of the database system component requiring access to the information within the catalog 88 is executed. In one embodiment, this comprises the query explain program 50 receiving a command from a user to execute a function requiring the information from the catalog 88. Upon so doing, the catalog querying module 86 is consulted, and in turn consults the catalog qualifier storage module 110.

> At a step 150, the user-generated copy is integrally referenced. In the depicted embodiments, this comprises the catalog querying module 86 receiving the high level qualifier 112 from the catalog qualifier storage module 110 and passing it on to the requesting function of the query explain program 50. The query explain program 50 then executes the function, referencing the catalog copy 87, 89 as if it were the system catalog 88. The method 130 ends at a step 152." (emphasis added)

Applicant remarks that "it is improper not to consider the 'descriptors' and the 'wherein' clauses".

The Examiner has indeed considered such "descriptors" and such "wherein" clauses. A result of such consideration was a determination that the "descriptors" and "wherein" clauses did not contribute to the claims as a whole in distinguishing them from the disclosure of Couch. The rejection stated that the descriptors "private", "non-private", "user-defined", or "system" did not move to further define or distinguish the that which was claimed from the invention disclosed by Couch. The rejection further stated that the recitations couched within the "wherein" clause was given little patentable weight because the language did not refer to a positive recitation of a deleting step forming part of the claimed invention. The consideration of the "descriptors" and the "wherein" clauses has resulted in the above determinations.

Applicant remarks that the "descriptors" and "wherein" clauses should be accorded "proper patentable weight".

The Examiner's position is that he has accorded the proper patentable weight to the claims and Applicant has not offered remarks directed to the manner in which the "descriptors" and "wherein" clauses do, indeed, contribute to the claims as a whole in distinguishing from the disclosure of Couch. Accordingly, the Examiner is not persuaded that patentable weight different from that already afforded the claim language should be afforded.

Applicant attempts to invalidate the Examiner's position by characterizing it as a "technical rejection".

The Examiner notes that the cited portions of the MPEP (i.e. MPEP 706.03 and MPEP 2173.01) are discussions of non-prior art rejections as "technical rejections". In the instant case, the Examiner has not offered any "technical rejection" of the use of the "descriptors" or the "wherein" clauses. For example, the Examiner has not rejected to the use of the various "descriptors" or phraseology of the "wherein" clauses, nor has the Examiner rejected the claims based on style of expression, format of the claim, or type of language used to define the

subject matter. Moreover, Applicant's characterization of the Examiner's position on this matter does not leave claims 2-20, 41-60, and 62-67 unexamined. These claims stand rejected under the prior art rejection reported above.

Applicant alleges that the Office action fails to provide full development of reasoning because it fails to provide any relevant section of the MPEP or where Applicant can find the "scale of patentable weight".

These arguments are not persuasive because they advance that a burden is on the Office to provide each and every relevant section of the MPEP to support the Examiner's reasoning. The MPEP provides guidance for the Examiner in conducting the Examination of the claims and in determining the degree to which claim language impacts the invention as a whole in distinguishing from the prior art. For example, Applicant's attention is directed to MPEP 2106(II)(c) which provided guidance for the review of the claims by Office personnel. There, of course, is no published "scale of patentable weight" as supposed by Applicant. The examination process involves more complex determinations than simple reference to a published "scale". As such, Applicant's characterization of the Examiner's determination of "little patentable weight" as being

something of finite and tangible value along some published and producible scale exults a hypothetical academic exercise over pragmatic claim evaluation and interpretation. Finally, Applicant's understanding that "the features of the claims are accorded or not accorded patentable weight" is not the understanding of the Examiner. To accord claim language "no patentable weight" is tantamount to "ignoring" the claim limitation. The Examiner has not ignored any of the claim limitations. The Examiner has weighed each and every limitation of the claim in context of the recitation of the invention, as a whole, and in light of a reading of the specification. A result of this process was the determination that the "descriptors" and "wherein" clauses identified did not provide any patentable moment in distinguishing the affected recitations from the methods, apparatus, and article of manufacture disclosed by Couch.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey A. Smith
Primary Examiner
Art Unit 3625

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